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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/602,191	06/22/2000	Graham Edmund Kelly	7579.001	8264

7590

01/29/2002

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EXAMINER

WILSON, JAMES O

ART UNIT

PAPER NUMBER

1623

DATE MAILED: 01/29/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
09/602,191

Applicant(s)
Kelly

Examiner
James O. Wilson

Art Unit
1623

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE THREE MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Jun 22, 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☒ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☒ All b) ☐ Some* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☒ Certified copies of the priority documents have been received in Application No. 08/338,567.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) ☒ Notice of References Cited (PTO-892) 18) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 19) ☐ Notice of Informal Patent Application (PTO-152)
- 17) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ 20) ☐ Other:

Art Unit:

The original patent, or an affidavit or declaration as to loss or inaccessibility of the original patent, must be received before this reissue application can be allowed. See 37 CFR 1.178.

The reissue oath/declaration filed with this application is defective (see 37 CFR 1.175 and MPEP § 1414) because of the following:

The declaration fails to state whether the inventor is the sole inventor of the invention claimed as required by 37 CFR 1.63(a)(4).

Claims 1-13 are rejected as being based upon a defective reissue oath under 35 U.S.C. 251 as set forth above. See 37 CFR 1.175.

The nature of the defect(s) in the oath is set forth in the discussion above in this Office action.

The nature of the defect(s) in the declaration is set forth in the discussion above in this Office action.

This application is objected to under 37 CFR 1.172(a) as the assignee has not established its ownership interest in the patent for which reissue is being requested. An assignee must establish its ownership interest in order to support the consent to a reissue application required by 37 CFR 1.172(a). The assignee's ownership interest is established by:

(a) filing in the reissue application evidence of a chain of title from the original owner to the assignee, or

(b) specifying in the record of the reissue application where such evidence is recorded in the Office (e.g., reel and frame number, etc.).

The submission with respect to (a) and (b) to establish ownership must be signed by a party authorized to act on behalf of the assignee. See MPEP § 1410.01.

An appropriate paper satisfying the requirements of 37 CFR 3.73 must be submitted in reply to this Office action.

Art Unit:

Claims 11-13 are rejected under 35 U.S.C. 251 as being an improper recapture of broadened claimed subject matter surrendered in the application for the patent upon which the present reissue is based. See *Hester Industries, Inc. v. Stein, Inc.*, 142 F.3d 1472, 46 USPQ2d 1641 (Fed. Cir. 1998); *In re Clement*, 131 F.3d 1464, 45 USPQ2d 1161 (Fed. Cir. 1997); *Ball Corp. v. United States*, 729 F.2d 1429, 1436, 221 USPQ 289, 295 (Fed. Cir. 1984). A broadening aspect is present in the reissue which was not present in the application for patent. The record of the application for the patent shows that the broadening aspect (in the reissue) relates to subject matter that applicant previously surrendered during the prosecution of the application. Accordingly, the narrow scope of the claims in the patent was not an error within the meaning of 35 U.S.C. 251, and the broader scope surrendered in the application for the patent cannot be recaptured by the filing of the present reissue application.

The composition of matter claims of the 08/338,567 patent were submitted in the following manner, with the following amendments in scope:

In preliminary amendment A, filed November 21, 1994, the originally filed composition claim 1 was drawn to the following:

1. A health supplement comprising health supplement amount of a phyto-oestrogen selected from genistein, daidzein, biochanin A, and/or formononetin.

The Original claims were rejected under 35 USC 103 over Zilliken 4,366,082 in the Office action dated September 10, 1996.

Subsequently, claim 1 was canceled and replaced with claim 29 in Amendment B, filed February 28, 1997. Claim 29 was drawn to the following:

29. A health supplement composition comprising an extract from soya or clover, said composition comprising any two or more phyto-estrogens of the group genistein, daidzein, biochanin A, and/or formononetin or the natural glycosides of any of said phyto-estrogens.

Art Unit:

The claims dependent from claim 29 all contain the open-ended transitional phrase limitation "comprising". The Amendment filed February 28, 1997, in response to the Office action mailed September 10, 1996, the first occurrence of pharmaceutical preparations are set forth. These preparations were first claimed in claim 36. Claim 36 was drawn to the following:

36. A pharmaceutical preparation, in a solid dosage unit form, consisting essentially of any two or more concentrated phytoestrogen-derived isoflavones selected from the group consisting of genistein, daidzein, biochanin A, and/or formononetin or the natural glycosides of any of said phytoestrogens.

This initial recitation of the term "consisting essentially of" was originally presented in claim 36 by applicant in the amendment filed February 28, 1997.

In an interview with applicant's attorney on May 1, 1997, the examiner notes there was a suggestion to cancel composition claims. In the amendment that followed, applicant did indeed cancel many of these claims, specifically 2, 3, 5-9, 21, 22, 30 and 36.

In the Amendment filed May 6, 1997, applicant's representative submitted a new claim, which was of a different scope than claim 36, wherein the terms "consisting essentially of" was specifically narrowed by applicant's amendment to "consisting of". This change in transitional language is seen to be subject matter applicant surrendered during the prosecution of the original application.

In fact, the examiner suggested broadening the scope of the pharmaceutical preparation claim to the scope originally presented by applicant in the amendment filed February 28, 1997 directed to the allowed compositions, which are pharmaceutical preparations containing the transitional language "consisting essentially of". Here, applicant had ample opportunity to assert their desire to broaden the claims, however, applicant's narrowed the scope of the claims by choice. The examiner broadened the pharmaceutical preparation claims by Examiner's Amendment to the original scope as presented in the February 28, 1997 amendment filed by applicant.

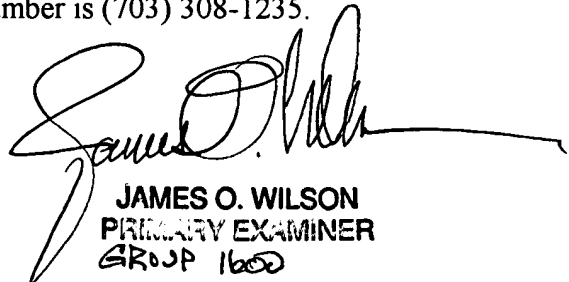
Art Unit:

The two step test for recapture supports the examiner's position here. Specifically, the subject matter applicant intends to claim in the reissue claims is indeed broader than those set forth in the claims as allowed. The term "comprises" is open language which broadens the scope of the claims containing the transitional phrase "consisting essentially of".

Any inquiry concerning this communication or earlier communications from the examiner should be directed to James O. Wilson, Primary Examiner in Art Unit 1623 whose telephone number is (703) 308-4624. The examiner can normally be reached on Monday-Friday from 10:00am to 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Geist, can be reached on (703) 308-1701. The fax phone number for the organization where this application or proceeding is assigned is (703) 308-4556.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1235.



JAMES O. WILSON
PRIMARY EXAMINER
GROUP 1600